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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,692

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James B. McCormick

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EXAMINER

JARRETT, LORE RAMILLANO

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

03/01/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

**Office Action Summary****Application No.**

10/723,692

**Applicant(s)**

MCCORMICK, JAMES B.

**Examiner**

LORE JARRETT

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/16/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/26/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 12/10/09

**DETAILED ACTION**

***Response to Amendment***

***Status of Claims***

1. In applicant's reply filed on 11/16/09, applicant amended claims 1, 2, and 5-7. Claims 8-10 were cancelled. Claims 1-7 are pending and are under examination.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 12/10/09 is acknowledged. Accordingly, the information disclosure statement is being considered by the examiner.

***Prior art rejections***

3. In light of applicant's amendments, the prior art rejections are withdrawn. New rejections follow.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 2, and 6** are rejected under 35 U.S.C. 102(b) as being anticipated by Pagano (US 3996006, newly cited).

As to claim 1, in figs. 1-5, Pagano discloses device for processing tissue, comprising: a foldable liquid permeable sheet (i.e. 2) having edges; a liquid permeable target (i.e. 26) disposed on the foldable liquid permeable sheet within the edges of the

sheet, thereby providing extended flap portions which flap portions are foldable to overlap the liquid permeable target; and a malleable material securing strip (i.e. area where 52 is located) attached to the foldable liquid permeable sheet of a length sufficient to secure the folded flap portions overlapping the liquid permeable target. With regard to the histological examination liquid, such claim language does not structurally define the claimed device. (i.e. col. 1, line 55 to col. 2, line 62).

As to claim 2, Pagano discloses that the malleable material securing strip is attached at an edge of the liquid permeable sheet (see figs. 1-2).

As to claim 6, Pagano discloses that the liquid permeable target is a liquid permeable paper sheet having a glue spot located thereon for attaching the examination liquid permeable target to the foldable examination liquid permeable sheet (i.e. see figs. 1-4, col. 1, line 55 to col. 2, line 12, language after "for" is intended use language).

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagano in view of Rochette (US 3537636, previously cited).

See Pagano Supra.

Pagano does not specifically disclose having a malleable securing strip comprising a metal wire or a metal foil.

In figures 1-4, Rochette discloses an invention consisting of a reclosable bag formed from a sheet of flexible material. The bag further comprises a bendable metal wire and a pair of flexible coverings strips (i.e. metal foil), which are sealed together and the wire is sandwiched between so that the wire is embedded between the strips (i.e. column 2, line 70 to column 3, line 8).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the malleable securing strip of Pagano, with a metal wire or with a metal foil because it would be beneficial to have a sealing means that provides reinforcement.

8. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pagano in view of Williamson et al. ("Williamson," US 5817032, previously cited).

See Pagano *supra*.

Pagano does not specifically disclose a release agent coated on the liquid permeable target.

Williamson discloses in his abstract, placing a tissue biopsy sample on a tissue trapping and supporting material that can withstand tissue preparation procedures and which can be cut with a microtome. Williamson further discloses spraying a thin layer of agar or other gel over the tissue and filter (i.e. col. 16, lines 43-59).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Pagano's liquid permeable target by adding a binder, such as agar, to the tissue sample because adding agar to tissue samples is well known as "cell

block preparation," which is a technique that allows the user to easily prepare the sample for analysis (i.e. Williamson, col. 1, lines 32-37).

9. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pagano in view of Lorincz (US 5812312, newly cited).

See Pagano *supra*.

Pagano does not specifically disclose an X and Y coordinate marking lines centered on the liquid permeable target.

Lorincz discloses in FIGS. 1 and 2, a microscope slide 11 having a viewing area 12, a dye 13 applied to the viewing area 12 for staining a biological sample 14, and a flexible transparent tape or film 16 attached to the slide 11 by means of a weak adhesive (not shown) such that the film 16 can be peeled back to expose the viewing area 12 for placement of the biological sample 14 thereon for intermixture with the dye 13, and replaced such that the stained sample can be viewed under a microscope. Alternatively, the dye 13 can be applied to the film 16 at a location opposite the viewing area 12 of the slide 11. For example, the dye may be admixed with the adhesive on the film. The microscope slide can be either rigid or flexible. Rigid slides are well known in the art and typically comprise glass or hardened plastic; however, flexible slides are not previously known in the art. A flexible slide allows the slide 11 to be folded over or bent such that the viewing area 12 is presented to be touched directly to the specimen or suspected tissue lesion 21 (e.g. syphilitic chancre) in order to obtain a sample therefrom, as illustrated in FIG. 5. Other features which are beneficial include the addition of size references, such as fluorescent microspheres of known dimension (e.g.

1  $\mu\text{M}$ ), to the surface of the slide or the film such that they coincide with the field of focus of the specimen. For example, the microspheres can be attached to the adhesive on the film or the microspheres may be placed in the dye before application of the dye to the slide such that they are held to the slide with the subsequently dried dye.

Microspheres 24 applied to the surface of culture media 23 are illustrated in FIG. 4. This facilitates focusing the microscope and provides an internal reference standard for size, which is preserved for photomicrography or video image capture. Other reference standards, such as a sizing grid 19 or the like, can also be incorporated as by etching or photographic reproduction onto the surface of the slide or film to allow sizing and quantitation of cells, microorganisms or the like. (i.e. col. 3, line 20 to col. 4, line 49).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Pagano's liquid permeable target by incorporating a reference standard grid on Pagano's liquid permeable target because it would be desirable to have a system to allow the analyst to easily take measurements of the sample.

10. **Claims 1, 2, and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Larka et al. ("Larka," US 5932430, newly cited) in view of Pagano.

As to claim 1, in figs. 1-2, Larka discloses device for processing tissue, comprising: a foldable liquid permeable sheet (i.e. 10) having edges; and a liquid permeable target (i.e. 20) disposed on the foldable liquid permeable sheet within the edges of the foldable examination sheet and attached with a glue spot (i.e. col. 7, line 65 to col. 8, line 2), thereby providing extended flap portions which flap portions are foldable to overlap the liquid permeable target. With regard to the histological

examination liquid, such claim language does not structurally further define the claimed device. (i.e. col. 3, lines 42-54 and col. 4, lines 11-23).

As to claims 1 and 2, Larka does not specifically disclose a malleable securing strip attached at an edge of the liquid permeable sheet.

Pagano discloses a malleable securing strip attached at an edge of the liquid permeable sheet (see *supra*).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Larka's liquid permeable sheet by incorporating a malleable securing strip, as disclosed by Pagano, because it would be desirable to prevent Larka's front panel from being inadvertently opened.

As to claim 6, the modified Larka discloses that the liquid permeable target is a liquid permeable paper sheet having a glue spot located thereon for attaching the examination liquid permeable target to the foldable examination liquid permeable sheet (i.e. col. 7, line 55 to col. 8, line 15, language after "for" is intended use language).

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORE JARRETT whose telephone number is (571)272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/22/10

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797